REMARKS

In this Response, Applicants amend claims 1, 4, 5, 6, 12, 15-19, 22, and 25-38 and traverses the Examiner's rejections. Silence with regard to any of the Examiner's rejections should not be construed as acquiescence to any of the rejections. Specifically, silence with regard to any of the rejections of the dependent claims that depend from an independent claim considered by Applicants to be allowable based on the Amendment and/or Remarks provided herein should not be construed as acquiescence to any of the rejections. Rather, silence should be construed as recognition by the Applicants that the previously lodged rejections are moot based on the Amendments and/or Remarks submitted by the Applicants relative to the independent claim from which the dependent claims depend. Applicants reserve the option to further prosecute the same or similar claims in the instant or a subsequent application. Upon entry of the Amendment, claims 1-28 are pending in the instant application.

Telephone Interview

Applicant acknowledges with appreciation the courtesy extended by the Examiner in conducting a telephone interview on April 24, 2003 with Applicants' Attorney, in which the Examiner and Applicant's Attorney discussed features of the present application that distinguish the cited prior art.

Extension of Time

As provided in accompanying documents, Applicants request a one-month extension of time in which to file this Response.

Amendments to the Claims

Applicants amend claims 6, 12, 17, 19, 22, and 27 to add the term "data" to modify the term "storage capacity." Applicants consider the term "storage capacity" to inherently include the meaning provided in the added term and thus amends claims 6, 12, 17, 19, 22, and 27 to explicitly state such inherent meaning. Applicants' amendment is supported by page 14, lines 13-14 of Applicant's originally filed specification, which states that "[t]he controller may store data onto each tape until the tape is full, or incapable of taking new data." Applicants do not consider this amendment to narrow the scope of claims 6, 12, 17, 19, 22, and 27. See Bose Corp. v. JBL, Inc., 274 F.3d 1354, 61 U.S.P.Q.2d 1216 (Fed. Cir. 2001). Further, Applicants do not consider this amendment to be related to patentability.

Applicants amend claims 1, 4, 5, 15, 16, 17, 18, 22, and 25 to address issues related to antecedent basis and consistency of claim terminology among claim species. Applicants do not consider this amendment to narrow the scope of claims 1, 4, 5, 15, 16, 17, 18, 22, and 25. Further, Applicants do not consider this amendment to be related to patentability.

Support for the amendments to the claims can be found throughout the Applicant's originally filed application. The amendments to the claims thus do not provide new matter.

Office Action ¶ 2

Applicants acknowledge with appreciation the Examiner's consideration of Applicant's November 18, 2002 Information Disclosure Statement.

Office Action ¶ 3

The Examiner rejected claims 1, 5, 6-9, 12-28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,758,359 to Saxon in view of U.S. Patent No. 5,604,900 to Iwamoto et al. (hereinafter referred to as Iwamoto).

The Examiner rejected claims 2-4, 10-11 under 35 U.S.C. § 103(a) as being unpatentable over Saxon and Iwamoto and further in view of U.S. Patent No. 6,023,709 to Anglin et al. (hereinafter referred to as Anglin).

Claims 1-5

Applicants' independent claim 1 is directed to a process for storing data. Among other things, Applicants' independent claim 1 includes storing data on data storage elements; recording a time signal representative of the time of storing data; *detecting a condition representative of each data storage element having reached a data storage capacity; based on the condition, comparing time signals for each data storage element*; and, *based on the time signal comparison, storing data on the data storage element having the earliest recorded data.*

Saxon describes a system for retroactively backing up data files. Saxon backs up data files by comparing a total save set size with a user-specified maximum size threshold. (Saxon col. 7, ll. 41-50 and Saxon Fig. 3b.) As discussed during the Telephone Interview on April 24, 2003, Saxon's maximum size threshold does *not* represent the *data storage capacity* of the Saxon *storage medium*, in contrast to Applicants' independent claim 1. Rather, Saxon's maximum size threshold is "the maximum amount of data that can be backed up in the allotted

backup time" (Saxon col. 7, ll. 25-27) and is thus a *processing time capacity* of the Saxon processor, and *not* a *data storage capacity of a data element*, as claimed by Applicants.

Since the Saxon maximum size threshold does not represent, consider, or otherwise account for the storage capacity of the Saxon storage medium, Saxon is different from the claimed method of independent claim 1 in that Saxon does not *detect a condition representative of the storage capacity of the storage medium*. Since Saxon does not detect the condition, Saxon also cannot perform either of the claimed *directing of a processor to compare time signals based on detecting the condition* or *directing the processor to store data on the data storage element having the earliest stored data based on the time signals*. Accordingly, Saxon does not teach the aforementioned several features of Applicants' independent claim 1.

Further, regardless of the meaning of the Saxon maximum size threshold, Saxon still does not teach the feature of Applicants' claim 1 that includes *directing the processor to store data on the data storage element having the earliest recorded data*. Before storing data, Saxon generates save sets as a compilation of requests to store data. Saxon thereafter determines whether the size of a save set exceeds the maximum threshold, and if so, Saxon reduces the save set by eliminating the most recent save set from the total save set until the total save set size satisfies the maximum size threshold. (Saxon col. 7, ll. 37-39.) Saxon *then* stores the reduced save set. Although Saxon teaches a comparison, Saxon's comparison is with respect to *requests for storage, prior to storage*, and Saxon does not contain any teaching directed to comparing the timestamps of storage elements having the earliest recorded data, as claimed by Applicants. Accordingly, as provided previously herein, regardless of the meaning of the Saxon maximum size threshold, Saxon still does not teach the feature of Applicants' independent claim 1 that includes *directing the processor to store data on the data storage element having the earliest stored data*.

Iwamoto describes a file expansion system. In contrast to Applicants' independent claim 1, Iwamoto does not contain any teaching directed to *detecting a condition representative of each storage element having reached capacity; based on the condition, directing the processor to compare the time signals for each data storage element;* and, *storing data on the data storage element having the earliest stored data.*

As Examiner knows, to establish a prima facie case of obviousness under 35 U.S.C. 103(a), Examiner must at least show that all elements of Applicants' claims are satisfied by the

purported combination. As provided herein, neither Saxon nor Iwamoto, alone or in combination, teaches all features of Applicants' independent claim 1. Examiner thus fails to satisfy the requirements of 35 U.S.C. 103(a) for at least this reason, and Applicants' failure to address the motivation and reasonable expectation of success elements of 35 U.S.C. 103(a) is not an admission that such elements are satisfied, but rather a recognition that such elements are moot given the failure of Examiner to satisfy a showing of all-elements. Because Examiner fails to provide a prima facie case of obviousness at least for failing to show all elements of independent claim 1 may be satisfied by a hypothetical combination of Saxon and Iwamoto, Applicants consider independent claim 1 to be allowable. Since claims 2-5 depend from independent claim 1, Applicant also considers claims 2-5 to be allowable as depending on an allowable base claim.

Claims 6-11

Applicants' independent claim 6 is directed to a method of storing data. Among other things, independent claim 6 includes detecting a condition representing a *data storage capacity* of at least one of at least two *data storage elements*; and, based on the detected condition, *storing the data on the data storage element associated with an earliest time of storage*.

As previously provided herein with respect to independent claim 1, neither Saxon nor Iwamoto, whether considered separately or in combination, teaches the features of *detecting a condition representing a data storage capacity of data storage elements*, or, *storing data on the data storage element having the earliest recorded data*. As provided previously herein with respect to independent claim 1, Examiner also fails to provide a prima facie case of obviousness under 35 U.S.C. 103(a) for at least failing to show that all-elements of Applicants' independent claim 6 are taught by the art included in the purported combination.

Applicants thus traverse Examiner's rejection of independent claim 6 based on 35 U.S.C. 103(a), and Applicants consider independent claim 6 to be allowable. Since claims 7-11 depend from independent claim 6, claims 7-11 are also allowable as depending on an allowable base claim.

Claims 12-16

Applicants' independent claim 12 is directed to a method of storing data that includes detecting a condition representing a *data storage capacity* of at least one of at least two data

storage elements; based on the detected condition, determining whether at least one of the at least two data storage elements includes available data storage capacity; and, based on whether at least one of the at least two data storage elements includes available data storage capacity, *storing the data on the data storage element associated with an earliest time of storage.*

As previously provided herein with respect to independent claims 1 and 6, neither Saxon nor Iwamoto, whether considered separately or in combination, teaches the features of *detecting a condition representing a data storage capacity of data storage elements*, or, *storing data on the data storage element having the earliest recorded data.* As provided previously herein with respect to independent claims 1 and 6, Examiner fails to provide a prima facie case of obviousness under 35 U.S.C. 103(a) for at least failing to show that all-elements of Applicants' independent claim 12 are taught by the art included in the purported combination. Accordingly, Applicants consider independent claim 12 to be allowable. Since claims 13-16 depend from independent claim 12, claims 13-16 are also allowable as depending on an allowable base claim.

Claims 17-18 and 27-28

Applicants' independent claims 17 and 27 include features similar to those presented in independent claims 1, 6, and 12, which include at least, *detecting a condition representing a data storage capacity of at least one of at least two data storage elements.* As provided herein with respect to independent claims 1, 6, and 12, Examiner fails to show at least this element via the purported combination of Saxon and Iwamoto. With further regard to independent claims 17 and 27, it thus follows that neither Saxon nor Iwamoto can thus teach the claimed dependency of *based on the detected condition, determining whether at least one of the at least two data storage elements includes available capacity*, as neither Saxon nor Iwamoto teaches detecting the condition. Accordingly, at least because neither Saxon nor Iwamoto teaches this claimed feature, Examiner fails to provide a prima facie case of obviousness under 35 U.S.C. 103(a). Applicants thus traverse Examiner's rejection of independent claims 17 and 27 based on 35 U.S.C. 103(a), and Applicants consider independent claims 17 and 27 to be allowable. Because pending claims 18 and 28 depend from one allowable independent claims 17 and 27, respectively, dependent claims 18 and 28 are also allowable as depending from an allowable base claim.

Claims 19-25

Applicants' independent claims 19 and 22 are processor program claims that are companion claims to independent claims 6 and 12, respectively. As provided herein, independent claims 6 and 12 are allowable, and hence, independent claims 19 and 22 are allowable for the same reasons. Namely, neither Saxon nor Iwamoto teaches instructions to cause a processor to detect a condition representing a *data storage capacity* of at least one of at least two *data storage elements*; and, based on the detected condition, *store the data on the data storage element associated with an earliest time of storage*.

Since claims 20-21 and 23-25 depend from allowable independent claims 19 and 22, respectively, claims 20-21 and 23-25 are also allowable for depending on an allowable base claim.

U.S.S.N. 09/465,436
Group Art Unit: 2172

CONCLUSION

Applicants consider the Response herein to be fully responsive to the Office Action. Based on the foregoing Amendment and Remarks, Applicants respectfully submit that this application is in condition for allowance. Accordingly, Applicants request allowance. Applicants invite the Examiner to contact the Applicants' undersigned Attorney if any issues are deemed to remain prior to allowance.

Respectfully submitted,
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